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REMARKS

Claims 1-31 are pending in the present application. In the Office Action mailed January 3, 2005, the Examiner rejected claims 1-6, 8-13, 15-17, 19-23, and 30-31 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. (USP 5,442,541) in view of Fenstermaker et al. (USP 6,490,684 B1). The Examiner next rejected claims 24-29 under 35 U.S.C. §103(a) as being obvious over Hube et al. in view of Applicant's Admitted Prior Art and further in view of Fenstermaker et al.

The Examiner rejected claim 1 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Fenstermaker et al. MPEP §2142 states that "[t]he burden of establishing a prima facie case of obviousness falls on the Examiner." Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a prima facie case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "The fact that references can be combined or modified is not sufficient to establish prima facie obviousness." *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Applicant believes that a prima facie case of obviousness has not been established and one cannot be made based on the art of record because the art of record fails to teach each and every element of the claimed invention.

The Examiner stated that Hube et al. teaches "wherein the electronic request is transmitted via a public communication interface (see for example; col 10, ln 15-26 and ln 39-44)." Office Action, p. 3. The Examiner further stated that Fenstermaker et al. teaches "including

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authorizing transmission and installation of a software key in response to an electronic request [see col. 3, lines 1-23], wherein the transmission of the software key is via a private communication interface such that the private communication interface connects to the centralized facility to the device [col. 3, lines 1-5, and col. 5, lines 1-12].” Office Action, p. 3.

Hube et al. teaches a remote communication system connecting a remote host to a local machine. See col. 10, lns. 15-17. A remote communication system connects the remote host to the local machine “through a suitable channel such as telephone line 175 or such as local and wide area networks, cellular phone channels, infrared links, and serial channels such as RS232 and SCSI.” Col. 10, lns. 15-20, 39-44. Hube et al. teaches that modem 182 serves “to connect line 175 to machine 30 for transmittal of the machine physical data from machine 30 to the remote host 157 and reconfiguration data from remote host 157 to machine 30.” Col. 10, lns. 39-44. While Hube et al. teaches a communication system having a communication channel and a modem for connecting the remote host to the local machine, Hube et al. fails to teach that the communication channel is public or private. Furthermore, Hube et al. fails to teach or suggest changing or switching from a public communication format to a private communication format, or vice-versa. Nevertheless, without the requisite support, the Examiner concluded that Hube et al. discloses a “public” interface.

Fenstermaker et al. teaches that the key “can be supplied to the user in writing, over the phone, via email, or via facsimile. . . .” Col. 3, lns. 1-4. Fenstermaker et al. also teaches another transmission method whereby “the key is generated by the remote source (step 420) and transmitted to the ultrasound device 100 via the key receiver 150, which can be, for example, a network link or modem (step 430).” However, similar to Hube et al., Fenstermaker et al. fails to teach or suggest the transmission of the key to the device by either public or private means. In fact, Fenstermaker et al. teaches a transmission similar to that of Hube et al.

Although Hube et al. teaches a communication modem and Fenstermaker et al. teaches a network link or modem, neither reference teaches or suggests whether the communication connection is public or private. The Examiner has merely assumed one to be public and the other to be private notwithstanding that the references, singly or combined, fail to teach transmitting an electronic request over a public communication interface and transmitting a key over a private communication interface as called for in claim 1. Despite the teachings of similar communication hardware in the references -- a modem as taught in Hube et al. and a network link or modem as taught in Fenstermaker et al. -- and a failure to teach or suggest communicating either publicly or privately, the Examiner, nevertheless, concluded that Hube et al. teaches that an electronic

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request is transmitted via a public communication interface and that Fenstermaker et al. teaches transmission of the software key via a private communication interface such that the private communication interface connects the centralized facility to the device. There is no teaching or suggestion in the prior art, either singly or when combined, to suggest such a conclusion other than hindsight gained from the invention itself.

Since the prior art fails to teach each and every element of the claimed invention, a prima facie case of obviousness has not been established, and Applicant believes that claim 1 and the claims that depend therefrom are patentable over the prior art.

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Fenstermaker et al. The Examiner stated that "Hube does not explicitly teach receiving a host ID input, wherein the host ID corresponds to a physical location of a device." Office Action, p. 4. The Examiner stated that Fenstermaker et al. teaches "wherein the host ID corresponds to a physical location of the device (see for example, Ethernet Hardware id) [col. 3, ln 31-40, and col. 4 ln 45-57, col. 5 ln 1-13]." Id. The Examiner further stated that, "Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a method of receiving a host id that corresponds to a physical location of the device as taught by Fenstermaker and implement it within the system of Hube, in order to generate unique keys for each device according to their identification." Office Action, pp. 4-5. Applicant respectfully disagrees.

As stated above, to establish a prima facie case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Claim 9 calls for a remote centralized facility that includes a computer programmed to receive a host ID input, wherein the host ID corresponds to a physical location of the device. Neither Fenstermaker et al. nor Hube et al. teaches or suggests a computer at the centralized facility to include a computer programmed to receive a host ID input, wherein the host ID corresponds to a physical location of the device. The Examiner concluded that Fenstermaker et al. teaches wherein the host ID corresponds to a physical location of the device and provided references in Fenstermaker et al. to support the conclusion -- namely, col. 3, ln 31-40, and col. 4 ln 45-57, col. 5 ln 1-13. However, these references do not teach or suggest a computer programmed to receive a host ID input, wherein the host ID corresponds to a physical location of the device. Instead, the references teach key generation and transmittal (see col. 3,

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Ins. 34-40), key composition and methods of using the key (see col. 4, Ins. 45-57), and key encryption and decryption using public and/or private keys (see col. 5, Ins. 1-13). None of these citations teach or suggest the remote centralized facility as including a computer programmed to receive a host ID input, wherein the host ID corresponds to a physical location of the device.

Furthermore, as stated above the Examiner stated that Fenstermaker et al. teaches "wherein the host ID corresponds to a physical location of the device (see for example, *Ethernet Hardware id*). Office Action, p. 4. One skilled in the art would not recognize that an Ethernet hardware id corresponds to a physical location. That is, the Ethernet hardware id identifies the hardware but not the physical location of the hardware. Also, Fenstermaker et al. fails to teach or suggest the receipt of an Ethernet hardware id by a computer at a remote centralized facility. Fenstermaker et al. teaches that "[o]ther public keys can include an Ethernet hardware id, a number generated by a block-dongle located on a port, or any other unique number stored in the ultrasound device." Col. 5, Ins. 10-13. Thus, while the key may include an Ethernet hardware id, Fenstermaker et al. fails to teach or suggest receiving a host ID input, wherein the host ID corresponds to a physical location of the device.

Since the prior art fails to teach each and every element of the claimed invention, a prima facie case of obviousness has not been established. Applicant believes that claim 9 and the claims that depend therefrom are patentable over the prior art.

In rejecting claim 17 under 35 U.S.C. §103(a), the Examiner failed to show that each and every element is taught or described in the prior art. Neither Fenstermaker et al. nor Hube et al. teaches or suggests displaying a GUI configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device and transmitting the code to the device having the inactive option over a second communication interface different from the first communication interface. Specifically, the references disclose a common communication interface as discussed above. Applicant believes that claim 17 and the claims that depend therefrom are patentably distinct from the art of record.

The Examiner next rejected claim 24 under 35 U.S.C. §103(a) as being obvious over Hube et al. in view of Applicant's Admitted Prior Art and further in view of Fenstermaker et al. As stated above, to establish a prima facie case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Claim 24 calls for a software key generation tab, whereupon

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user selection of the software key generation tab transmits a data transmission over a public communication connection to the centralized processing center, and wherein the data transmission represents a request to activate the inactive software program resident in memory of the medical imaging scanner over a private communication connection.

The Examiner has not shown that the prior art combination teaches or suggests that user selection of the software key generation tab transmits a data transmission over a public communication connection to the centralized processing center. The Examiner stated that "Hube discloses a means of transmitting data to the centralized processing center (see for example; fig 7 and col 14 ln 20-32). . . ." Office Action, p. 11. However, the Examiner has not shown that Hube et al. teaches transmission of data over a public communication connection to the centralized processing center. As stated above, although Hube et al. teaches a communication modem and Fenstermaker et al. teaches a network link or modem, neither reference teaches or suggests whether the communication connection is public or private. Therefore, neither reference teaches or suggests user selection of the software key generation tab that transmits data over a public communication connection to the centralized processing center.

Further, the Examiner stated that "[t]he combination of Hube and AAPA does not explicitly teach data transmitting over a private communication connection." Office Action, p. 11. The Examiner stated that Fenstermaker et al. teaches "a method of enabling device features by requesting and receiving a key from a remote location [see abstract, col. 3 ln. 29-38], including authorizing transmission and installation of a software key in response to an electronic request [see col. 3, lines 1-23], wherein the transmission of the software key is via a private communication interface such that the private communication interface connects the centralized facility to the device [col. 3, lines 1-5, and col. 5, lines 1-12]." Office Action, p. 12. Fenstermaker et al. does not teach or suggest that the communication connection is public or private. Further, the references neither teach nor suggest data transmission over a public communication connection that represents a request to activate of an inactive software program resident in memory of the medical imaging scanner over a private communication connection.

Since neither Hube et al. nor Fenstermaker et al. teaches or suggests each and every element of the claimed invention, a prima facie case of obviousness has not been established. Applicant believes that claim 24 and the claims that depend therefrom are patentable over the prior art.

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Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-6, 8-13, 15-17, and 19-31.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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Dated: March 3, 2005
Attorney Docket No.: GEMS8081.081

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